

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : ERICKSON, John S.  
Serial No. : 10/781,145  
Confirmation No. : 6057  
Filing Date : February 17, 2004  
Group Art Unit : 2137  
Examiner : Paul Callahan

**APPEAL BRIEF  
On Appeal from Group Art Unit 2137**

Date: December 26, 2007

By: /Brian S. Myers/  
Brian S. Myers  
Attorney for Appellant  
Reg. No. 46,947  
For: Larry Liberchuk,  
Reg. No. 40,352  
Senior IP Counsel  
Philips Electronics N.A. Corporation  
914-333-9602

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## **I. REAL PARTY IN INTEREST**

The real party in interest is Trustees of Dartmouth College, the assignee of record, which is a licensor to Digimarc Corporation, which in turn is a licensor to Koninklijke Philips Electronics N.V.

## **II. RELATED APPEALS AND INTERFERENCES**

Appellant is not aware of any pending appeals, judicial proceedings, or interferences which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

## **III. STATUS OF CLAIMS**

- a) Claims 8-12 and 14 are pending. Claims 8 and 14 being independent.
- b) Claims 8-12 stand rejected and are the subject of this appeal.
- c) Claims 1-7, 13 and 15-20 are cancelled.

## **IV. STATUS OF AMENDMENTS**

The claims listed in section "VIII. Claims Appendix" of this Appeal Brief correspond to the claims submitted in Appellant's response of May 7, 2007. No claim amendments have been submitted following Appellant's response of May 7, 2007 nor are any claim amendments pending.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The claimed invention, as recited in claim 8, is directed to a method of controlling use of a content object that includes text, (page 16, line 10 to page 17, line13; Fig. 8) the method including: receiving data representing the object at a user device (page 28, line 22 to page 29, line 7); receiving at the user device an initial set of data representing usage rights associated with said object (page 32, lines 6-12, page 41, lines 1-18, and Fig. 7a), the initial set of data defining a first set of rights that are permitted (page 32, lines 8-12, page 35, lines 15-30), and a second set of rights that are not permitted (page 32, lines 9-12; page 35, lines 15-30); and upon receiving a request to perform a function using said content, checking said initial set of data representing usage rights to determine whether said function should be allowed (page 41, lines 10-27), and wherein a drag and drop function is among those that are not permitted (page 35, lines 15-30).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 8-11 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,694,608 (hereinafter Shostak) in view of US 5,495,607 (hereinafter Pisello).

Whether claim 12 is properly rejected under 35 U.S.C. §103(a) as being unpatentable over Shostak, Pisello and US 4,888,798 (hereinafter Earnest).

## **VII. ARGUMENT**

Appellant respectfully traverses the rejections in accordance with the detailed arguments set forth below.

**A. Claims 8-11 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Shostak in view of Pisello.**

1. Independent claim 8

Appellant respectfully submits that the Office has not established a *prima facie* case of obviousness, as is required under 35 U.S.C. 103 and established cases. For example, the combination of Shostak in view of Pisello, fails to teach or suggest every feature recited in Appellant's claim 8.

Applicant's claim 8 recites: "upon receiving a request to perform a function using said content, checking said initial set of data representing usage rights to determine whether said function should be allowed, and wherein a drag and drop function is among those that are not permitted."

The Examiner conceded that "Shostak does not teach that a drag and drop function is among those that are not permitted" (final Office Action bottom of page 3, top of page 4). However, Pisello, col. 18, lines 47-63 is pointed to as allegedly teaching that the ability to utilize a drag-and-drop operation is dependent on evaluation of permission data associated with the content data (see page 4 of the Office Action).

As previously pointed out to the Examiner, a review of Pisello, particularly col. 18, lines 47-63, does not find support for this assertion on page 4 of the final Office Action. In fact Pisello teaches "the user then drags-and-drops a copy of the highlighted block into a directory entry of a second server, which directory entry is also shown on the screen. Depending on the context, the domain administrating server (DAS) 150 can responsively issue appropriate permissions to allow the corresponding transfer to take place immediately across the network-linking backbone 105 or at a scheduled later time."

Thus, clearly Pisello is permitting the "drag and drop" function, it is simply a question of when the actual file transfer takes place. Whether it occurs immediately or whether the server

schedules the transfer for a later time. However, appellant's claim limitation is not met since Pisello is permitting the function of "drag and drop" but may schedule the actual action of file transfer to a later time. Pisello's permissions allow the corresponding transfer to take place immediately or at a scheduled later time. There is nothing in Pisello concerning a drag and drop function not being permitted.

In the "Response to Arguments" section of the final Office Action, the Examiner alleges: "In the cited passages of Pisello, the requested drag and drop action is stopped until the user grants permission." However, nowhere is this taught in the cited section of Pisello (Col. 18, lines 47-63). Appellant could not find even a suggestion that Pisello teaches the user granting permission. As pointed out above Pisello only suggests that, depending on the context, the domain administrating server (DAS) 150 can responsively issue appropriate permissions to allow the corresponding transfer to take place immediately across the network-linking backbone 105 or at a scheduled later time. This is clearly different from appellant's claimed invention.

Thus, Pisello is not teaching that a drag-and-drop function is not permitted, but is describing that the transfer can either be done immediately or scheduled for a later time. In either case the transfer is permitted and performed.

Furthermore, contrary to the assertions in the final Office Action Pisello does not teach "operation is dependent on evaluation of permission data associated with the content data;" Pisello col. 18, lines 54-55 states "[d]epending on the context" (emphasis added).

In addition, it's asserted in the final Office Action that Shostak teaches, at col. 15, lines 55-67, appellant's claimed "upon receiving a request to perform a function using said content, checking said initial set of data representing usage rights to determine whether said function should be allowed."

However, a review of Shostak finds a completely different feature than that claimed by appellant. Shostak describes that a user can lock a document, thereby “graying out” or disabling tools. Nowhere does Shostak suggest receiving of a request and checking an initial set of data representing usage rights. Shostak teaches, upon a user command, simply disabling the tools. When the tools are disabled, if a user attempts to use a tool, there is no checking an initial set of data representing usage rights, as in appellant’s claim 8.

In Shostak the user simply cannot use the tool since it is “grayed out.” Thus, in contrast to appellant’s claim 8, Shostak has disabled the tools according to a prior user action of locking the design of a document and there is no suggestion of receiving of a request and checking an initial set of data representing usage rights.

In the “Response to Arguments” section of the final Office Action it appears the Examiner alleges opening a document and checking permission is equivalent to appellant’s claimed feature. However, the section of Shostak quoted by the examiner does not support the Examiner’s arguments. Additionally, even if Shostak taught such a feature of checking permission when opening a document, that is different from appellant’s claimed feature of “perform a function using said content.” Opening a document is not the same as a function using the content.

For at least the foregoing reasons, it is respectfully submitted that the combination of Shostak in view of Pisello, fails to teach or suggest each and every claimed feature. Therefore, a *prima facie* case of obviousness, as is required under 35 U.S.C. 103, has not been established and the rejection should be reversed.

## **2. Claims 9 and 10**

Claims 9 and 10 depend from independent claim 8, which has been shown to be allowable over the combination of prior art references. Accordingly, claims 9 and 10 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein.

In addition, the Examiner simply argues that Official Notice is taken that the limitations recited in these dependent claims is old and well known. The Examiner further admits neither of Shostak and Pisello teaches the claimed features.

Appellant respectfully submits that such features are not old and well known as asserted by the Examiner. Appellant's unique combination of elements together with the feature of "upon receiving a request to perform a function using said content, checking said initial set of data representing usage rights to determine whether said function should be allowed" is not found or suggested in the prior art and certainly is not so well known in the art that Official Notice can be taken according to MPEP 2144.03.

According to MPEP 2144.03 A: Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

According to MPEP 2144.03 B: Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in



the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

In the present case the Examiner admits the cited references fail to teach the claimed features. However, the Examiner fails to cite any references or provide any line of reasoning to support the Examiner's position that Official Notice can be taken. Accordingly, this rejection should be reversed.

### **3. Claim 11**

Appellant's claim 11 recites: "the second set of rights is expressly defined in said data representing usage rights, rather than being inferred by their absence from the first set of rights."

The Examiner lists this claim rejection with the rejection of claim 8, however, the Examiner does not address the features recited in claim 11. Appellant submits the features of claim 11 are not found or suggested in the combination of references cited by the Examiner.

Furthermore, claim 11 depends from independent claim 8, which has been shown to be allowable over the combination of prior art references. Accordingly, claim 8 is also allowable by virtue of its dependency, as well as the additional subject matter recited therein and the rejection should be reversed.

**B. Claim 12 is not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Shostak, Pisello and Earnest.**

### **1. Claim 12**

Claim 12 depends from independent claim 8, which has been shown to be allowable over the combination of prior art references Shostak and Pisello. The additional reference Earnest is only cited as allegedly showing the additional features of claim 12, which the Examiner admits is not found in Shostak or Pisello. However, Earnest fails to cure the deficiencies of Shostak and

Pisello. Therefore, the combination of references cannot render obvious dependent claim 12. Accordingly, claim 12 is also allowable by virtue of its dependency, as well as the additional subject matter recited therein.

**CONCLUSION**

In light of the above, appellant respectfully submits that the rejections of claims 8-12 are in error, legally and factually, and must be reversed.

Respectfully submitted,

Date: December 26, 2007

By: /Brian S. Myers/  
Brian S. Myers  
Attorney for Appellant  
Reg. No. 46,947

For: Larry Liberchuk,  
Reg. No. 40,352  
Senior IP Counsel  
Philips Electronics N.A. Corporation

Please direct all future correspondence to:  
Larry Liberchuk, Esq.  
Senior IP Counsel  
Philips Intellectual Property & Standards  
P.O. Box 3001  
Briarcliff Manor, NY 10510-8001  
Phone: (914) 333-9602  
Fax: (914) 332-0615  
Email: larry.liberchuk@philips.com

**VIII. CLAIMS APPENDIX**

1-7 (canceled)

8. (original) A method of controlling use of a content object that includes text, the method including:

receiving data representing the object at a user device;

receiving at the user device an initial set of data representing usage rights associated with said object, the initial set of data defining a first set of rights that are permitted, and a second set of rights that are not permitted; and

upon receiving a request to perform a function using said content, checking said initial set of data representing usage rights to determine whether said function should be allowed, and

wherein a drag and drop function is among those that are not permitted.

9. (original) The method of claim 8 wherein a modify function is among those that are not permitted.

10. (original) The method of claim 9 wherein printing and saving functions are among those that are not permitted.

11. (original) The method of claim 8 wherein the second set of rights is expressly defined in said data representing usage rights, rather than being inferred by their absence from the first set of rights.

12. (original) The method of claim 8 wherein, if said check determines that said function should not be allowed, then engaging in a transaction with a remote server that results in receipt of revised data representing usage rights at the user device.

13. (canceled)

14. (original) A method of controlling email comprising:

receiving data representing email at a user device;

receiving at the user device an initial set of data representing usage rights associated with the email, the initial set of data defining a first set of rights that are permitted; and

upon receiving a request to perform a function using the email, checking said initial set of data representing usage rights to determine whether the function should be allowed,

wherein a transmission function is among those that are not permitted, and

wherein upon a blocked transmission, querying a remote server to determine criteria for transmission, and if the criteria is met, receiving an updated set of data defining a second set of rights that are permitted, the second set of rights including transmission rights.

15-20 (canceled)

**IX. EVIDENCE APPENDIX**

No evidence has been submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title nor any other evidence entered by the examiner and relied upon by appellant in the appeal.

**X. RELATED PROCEEDINGS APPENDIX**

Appellant is not aware of any appeals or interferences related to the present application.